

REMARKS

After entry of this Amendment, claims 1, 3-8, 17, and 18 remain pending in the instant application. Claims 1, 3-5, and 8 are amended in this Amendment as described below. Claim 9 is presently cancelled. Claims 2 and 10-16 were previously cancelled. Claim 17 and 18 are new.

Independent claim 1 has been amended to state that “at least one of the first adhesion promoter and the second adhesion promoter is an organosilicon compound containing, per molecule, at least one silicon-bonded alkenyl group and at least one epoxy group.” Independent claim 1 has also been amended to replace the transitional phrase “consisting essentially of” with the term “contains” as presented originally. Claim 3 has been amended to depend from claim 17. Claim 4 has been amended such that both the first adhesion promoter and the second adhesion promoter further contain, per molecule, at least one alkoxy group, at least one alkoxyalkoxy group, or both. Claim 5 has been amended such that the first adhesion promoter and the second adhesion promoter further contain, per molecule, at least one silicon-bonded hydrogen atom. Claim 8 has been amended to merely correct a typographical error. Support for the amendments to claims 1, 3-5, and 8 can be found in at least claims 3, 4, 5, and 9 as originally filed, paragraphs [0037]-[0043] of the specification as published, as well as throughout the Examples. Support for new claims 17 and 18 can be found in at least claims 5 and 9 as originally filed and paragraphs [0037]-[0043] and [0046]. As such, no new matter has been introduced.

Prior to addressing the instant rejection, the Applicants note that in the Office Action dated June, 23, 2010, the Examiner misinterpreted the Applicant's comments in the Amendment dated March 22, 2010. On page 3 of the Office Action, the Examiner contends:

“B. Applicant states, in the paragraph bridging pages 5-6, that this reference teaches the newly-added components (A), (B), (C), an adhesion promoter, and optional additives.”

The Applicants did not specifically state this. Instead, the comments referred to by the Examiner from the Office Action dated June, 23, 2010, actually read:

“The compositions of the ‘265 patent contain additional essential components other than components (A), (B), (C), an adhesion promoter, and optional additives, as instantly claimed. In particular, the ‘265 patent also requires a curable epoxy resin and an organosilicon compound having at least one silanol group in a molecule to be present in the composition taught therein when components (A), (B), and (C) are present.”

To clarify, the Applicant's comments were framed in the context of the previous amendment transitioning to the terminology to “consisting essentially of” as well in the context of the Examiner's position that the ‘265 patent contains each and every element of the claims being rejected under 35 U.S.C. §102. More specifically, the quote above should have been read by the Examiner merely to mean that the compositions of the ‘265 patent contain additional essential components other than, i.e., instead of, the components that the Applicants were claiming in this application. Although awkward to some degree, the quote above is grammatically accurate as to this particular reading. As such, the Applicant's comments were intended to convey that even *assuming* the Examiner's position that the compositions of the ‘265 patent contain each and every element as claimed, the ‘265 patent contains additional essential components other than and different from those which were instantly claimed in this

application. In other words, what the Applicants were merely conveying was that it was not even necessary to evaluate whether or not the '265 patent disclosed the claimed composition because, in the context of the amendment to "consisting essentially of", it was most clear that the '265 patent had additional essential components. Therefore, the Applicant's comments referenced above were not an admission with respect to those claimed components (A), (B), (C), adhesion promoters, or optional additives in relation to the '265 patent as suggested by the Examiner.

Claims 1 and 3-9 stand rejected under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 5,714,265 to Meguriya et al. (hereinafter "the '265 patent") as evidenced by United States Patent No. 5,585,445 to Meguriya et al. (hereinafter "the '445 patent").

While Applicants make no concession as to the propriety of the Examiner's rejection of these claims based upon 35 U.S.C. §102(b), the Applicants have amended Claim 1 to facilitate prosecution. The Applicants respectfully submit that the rejection of independent claim 1 as being anticipated by the '265 patent is overcome through the instant amendment. In particular, by specifying that at least one of the first adhesion promoter and the second adhesion promoter is an organosilicon compound containing, per molecule, at least one silicon-bonded alkenyl group and at least one epoxy group, the Applicants are claiming the first and second adhesion promoters as distinct components from (A) the organopolysiloxane having an average of at least two silicon-bonded alkenyl groups per molecule, (B) the organopolysiloxane having an average of at least two silicon-bonded hydrogen atoms per molecule, and (C) the hydrosilylation catalyst for addition reactions of each of the first

addition-curable organopolysiloxane composition and the second addition-curable organopolysiloxane composition respectively. The Applicants note that the first and second adhesion promoters can be the same as or different from one another. The Applicants respectfully submit that independent claim 1 is both novel and non-obvious over the disclosure and teachings of the '265 patent, even as evidenced by the '445 patent.

As the Examiner is well aware, to properly establish anticipation under 35 U.S.C. §102, a reference must teach each and every element of a claim being rejected (see MPEP §2131). The '265 patent, even as evidenced by the '445 patent, does not expressly, or even inherently, disclose adhesion promoters let alone that at least one of the first adhesion promoter and the second adhesion promoter is an organosilicon compound containing, per molecule, at least one silicon-bonded alkenyl group and at least one epoxy group as is now claimed in amended Independent claim 1. Accordingly, the Applicants respectfully overcome the Examiner's rejection under U.S.C. §102(b).

The Examiner previously remarked, the '265 patent does not expressly refer to any adhesion promoters. Despite the '265 patent failing to recite an adhesion promoter, it was the Examiner's position that since the "Applicant has not expressly limited the term 'adhesion promoter' in the disclosure" that any component making up one of the layers may be considered as contributing to the physical bonding properties of the layer and may properly be considered an adhesion promoter. However, amended independent claim 1 specifically defines that at least one of the first adhesion promoter and the second adhesion promoter is an organosilicon compound containing, per molecule, at least one silicon-bonded alkenyl group and at least one epoxy group. Additionally, and as discussed above, each of

the first adhesion promoter and the second adhesion promoter are distinct from components (A), (B), and (C) of the first addition-curable organopolysiloxane composition and the second addition-curable organopolysiloxane composition, respectively.

Therefore, should the Examiner continue to assert that any component making up one of the layers in the '265 patent may be considered an adhesion promoter and should the Examiner contend that a first adhesion promoter and a second adhesion promoter as currently claimed are anticipated by a component of the '265 patent, the Applicants respectfully remind the Examiner that any component of the '265 patent which allegedly anticipates the first and second adhesion promoters as now claimed in amended independent claim 1 must be distinct from those components of the '265 patent the Examiner contends anticipate presently claimed components (A), (A'), (B), and (C) of both the first addition-curable organopolysiloxane composition and the second addition-curable organopolysiloxane composition respectively. For example, should the Examiner contend that a component of the '265 patent anticipates component (A) of the first addition-curable organopolysiloxane, the same component of the '265 patent cannot also anticipate the first adhesion promoter as currently claimed.

Independent claim 1 is clearly novel in view of the '265 patent which does not expressly, or even inherently, disclose a first adhesion promoter and a second adhesion promoter wherein at least one of the first adhesion promoter and the second adhesion promoter is an organosilicon compound containing, per molecule, at least one silicon-bonded alkenyl group and at least one epoxy group as is now claimed in independent claim 1 as amended. The remaining claims 3-8, 17, and 18 each depend upon the novel and non-

obvious features of independent claim 1 such that the Applicants respectfully submit that these claims are also novel and non-obvious. As such, the Applicants have overcome the rejection of claims 1 and 3-9 under U.S.C. §102(b).

The Applicants respectfully submit that the instant claims are in condition for allowance, and allowance is respectfully requested. The proper fee for a Request for Continued Examination (RCE) and a one-month extension of time is included herewith. While it is believed that no additional fees are presently due, the Commissioner is authorized to charge Deposit Account 08-2789 in the name of Howard & Howard Attorneys PLLC for any additional fees or to credit the account for any overpayment.

Respectfully submitted,

HOWARD & HOWARD ATTORNEYS PLLC

October 25, 2010
Date

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